





IN THE
Supreme Court of the United States

October Term, 1938.

No. 441.

THE ELECTRIC STORAGE BATTERY CO.,

Petitioner,

v.

GENZO SHIMADZU and NORTHEASTERN
ENGINEERING CORPORATION,

Respondents.

BRIEF FOR PETITIONER.

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THE ELECTRIC STORAGE BATTERY CO.,

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GENZO SHIMADZU AND NORTHEASTERN
ENGINEERING CORPORATION,

Respondents.

Brief for Petitioner.

This is a patent infringement suit, here on certiorari to the Circuit Court of Appeals for the Third Circuit.

OPINIONS OF THE COURTS BELOW.

The opinion of the District Court (R. II, 1162) is reported in 17 Fed. Supp. 42.

Memorandum amending opinion of the District Court after rehearing (R. II, 1189) is not officially reported.

The opinion of the Circuit Court of Appeals (R. II, 1223) is reported in 98 Fed. (2d) 831.

An opinion of the District Court upon defendant's application, with leave of the Circuit Court of Appeals, to take additional evidence after appeal had been perfected, is not

reported in the Federal Reporter, but is reported in 36 USPQ 25.¹

JURISDICTION.

The date of the judgment or decree of the Court below is August 8, 1938 (R. II, 1226).

Rehearing was denied September 14, 1938 (R. II, 1255).

Petition for certiorari was filed October 27, 1938.

The writ of certiorari was granted December 5, 1938.

The jurisdiction of this Court is invoked under Judicial Code, Sec. 240(a) as amended by the Act of February 13, 1935 (28 USC § 347(a)).

Cases believed to sustain the jurisdiction are:

Keller v. Adams-Campbell, 264 U. S. 314, 318,
319;

Appliance Co. v. Equipment Co., 297 U. S. 387,
392;

Triplett v. Lowell, 297 U. S. 638, 639;

Douglas v. Cunningham, 294 U. S. 207, 209;

Prudence Co. v. Fidelity Co., 297 U. S. 198, 205;

N. Y. Life Ins. Co. v. Viglas, 297 U. S. 672, 676.

STATEMENT OF THE CASE.

The parties plaintiff, respondents here, are Shimadzu, a subject of the Emperor of Japan and a resident of Japan, who is the patentee and owner of the patents alleged to be infringed, and Northeastern Engineering Corporation, exclusive licensee.

Defendant is The Electric Storage Battery Company, the petitioner here.

¹ That opinion is believed not pertinent to the issues here presented.

Six patents to Shimadzu were sued upon.²

The District Court adjudged (R. II, 1192)

Patents	Claims	Decree
1,584,149	1-2	valid and infringed
1,584,150	1-4, 6, 8-13	valid and infringed
1,896,020	10-11	valid and infringed

The remaining claims in issue of these and the other three patents in suit below were adjudged valid but not infringed.³

Upon appeal the decree of the District Court was affirmed on the findings and opinion of the District Court (R. II, 1223).

The claims here involved of patents 1,584,149 and 1,584,150 are for a method of producing a fine powder of lead by the abrasion of larger pieces of metallic lead in a dry state in a rotating mill under specified conditions.⁴

The claims of patent 1,896,020 that were held valid and infringed are for apparatus for carrying out the process.

² Patent	Claims	Application Filed	Patent Issued
1,584,149	1-2	Jan. 30, 1922	May 11, 1926
1,584,150	1-4, 6, 8-17	July 14, 1923	May 11, 1926
1,584,151	1-5	Apr. 18, 1924	May 11, 1926
1,584,152	1-2	Apr. 18, 1924	May 11, 1926
1,584,479	1-4	Feb. 20, 1923	May 11, 1926
1,896,020	10-11	Apr. 27, 1926	Jan. 31, 1933

³ The decree of the Court below, insofar as it adjudges any claims in issue valid but not infringed, is not here for review.

⁴ The Courts below found that the process of patent No. 1,584,149 differed from that of patent No. 1,584,150 in that the process of the former is carried out at room temperature and air is introduced into the mill to remove the powder from the mill, while in the latter, the process is carried out at elevated temperatures and air is introduced into the mill for oxidation purposes (R. II, 1166-7).

The product, "lead dust," is used in the manufacture of plates for storage batteries (R. II, 1162).

Petitioner is the manufacturer of the "Exide" batteries. It has been engaged in manufacturing storage batteries in Philadelphia since the latter part of the last century (R. I, 56).

The questions here presented are broadly these:

(1) Whether, under the patent statutes, Shimadzu can, by oral evidence of earlier conception and reduction to practice in Japan, take the date of his inventions back of petitioner's adjudged commercial use thereof at Philadelphia in June, 1921.

(2) Whether the patents in suit, even if otherwise valid, were not invalidated by Shimadzu's suppressing, concealing and withholding his inventions until long after the commercial use by petitioner in Philadelphia of its process and apparatus in June, 1921.

(3) Whether the adjudged commercial use by petitioner at Philadelphia of its process and apparatus in June, 1921 was not, in law, a public use and a bar to patents Nos. 1,584,150 and 1,896,020 because it was more than two years prior to the filing of the applications for these patents.

The questions here presented arise from facts not disputed and from concurrent findings of fact of both Courts below.⁵ Those facts are:

⁵ As concurrent findings of facts by the Courts below are not disturbed by this Court unless plainly without support, *Texas & N. O. R. Co. v. Brotherhood*, 281 U. S. 548, 558, and as respondents in their brief in opposition to the petition for certiorari (page 5) take the position that concurrent findings of the two Courts below constitute a deter-

(1) Petitioner began using, early in 1921, in Philadelphia, the process, and Hardinge Mills ⁶ for carrying out the process, which the Courts below held infringements of the patents in suit (R. II, 1175).

(2) In June, 1921, petitioner began *commercial* production by that process (R. II, 1192).

The Courts below found (R. II, 1192):

"It is therefore plain that there is no evidence of anything beyond an *experimental* use by the defendant earlier than about the middle of the year 1921

"*Commercial production* (by petitioner) ⁷ by the Hardinge Mill with its forced air draft undoubtedly involved the use of plaintiff's patent, and June 1921 may be fixed as the date when that began."

(3) The inventions of the patents here in issue were made by Shimadzu in Japan (R. II, 1162).

(4) Shimadzu made no disclosure of his inventions to anyone in the United States before he filed his applications for his United States patents. His inventions were not patented or described in any printed publication in this or any foreign country prior to the filing of his applications for the patents in suit.

(5) The dates upon which Shimadzu filed his applications for the patents here in suit and the dates of their grant, are:

mination which is not reviewable here, it is believed unnecessary here to review the evidence upon which such findings are based.

⁶ Hardinge Mills are described in R. III 4349.

⁷ Parenthetical expressions and emphasis throughout brief are counsel's.

Statement of the Case

Patents	Application Filed	Granted
1,584,149	Jan. 30, 1922	May 11, 1926
1,584,150	July 14, 1923	May 11, 1926
1,896,020	Apr. 27, 1926	Jan. 31, 1933

(6) Shimadzu has no foreign patent for the invention of patent 1,896,020.

The Courts below found (R. II, 1172) that Shimadzu's Japanese patent 60,825 (R. III-27), applied for February 3, 1923,

"corresponds very closely with U. S. '150.'"

Petitioner contended, but the Courts below denied, (a) that Shimadzu's Japanese patents 41,728 and 42,563 (R. III-20, 22), applied for November 21, 1920 and November 27, 1920, respectively, are for the inventions of the two claims of patent 1,584,149, applied for January 30, 1922; and (b) that his Japanese patent 42,563 is for the same invention as the process claims of patent 1,584,150, applied for July 14, 1923 (R. II, 1172).

(7) To enable Shimadzu to carry the date of his inventions of the patents in suit back of June, 1921, the date upon which petitioner began in Philadelphia the commercial use of its process and apparatus found to infringe, the Courts below permitted respondents, over the objection of petitioner (R. I, 140, 141, 143, 152) to adduce evidence, consisting of oral testimony, drawings and purported copies of alleged notebook entries, that Shimadzu conceived and reduced the inventions to practice in Japan, and the date thereof.

(8) Upon such evidence the Courts below found (R. II, 1166):

"I fix the date of invention and successful reduction to practice (In Japan) as not later than August 1919. . . ."

and held (R. II, 1178):

"The plaintiff is undoubtedly entitled to rely for priority upon the date of invention and reduction to practice as found, *regardless of the fact that the invention was made in a foreign country.*"

(9) In denying that Shimadzu's Japanese patent 42,563, applied for November 27, 1920, is for the same invention as the claims of patent 1,584,150, adjudged valid and infringed, the Courts below held (R. II, 1172):

"For whatever it may be worth it is pretty clear, that the plaintiff himself did not understand that, when he applied for Japanese '563 he was taking out a patent on the same process which appears in U. S. '150 because subsequently in Japan he took another patent, No. 60,825, which corresponds very closely with U. S. '150 and, being within the year does not invalidate it. *We are not concerned with the motives which prompted him, in taking out the '563 patent, to confine it to a single step of mechanical removal of the dust from the drum, and to withhold the really essential steps of the invention for later patenting. It is sufficient to say that he had the right to do this if he chose.*"

(10) Among the defenses set up in petitioner's answer were these (R. I, 35):

"Defendant avers that the claims of said letters patent are invalid and void because the subject matter thereof was, prior to the alleged invention thereof by Shimadzu, and for more than two years prior to his application dates, known to and used by the defendant at Philadelphia, Pennsylvania, and by the Willard Storage Battery Co. at Cleveland, Ohio "

And (top of page 34, R. I):

"... Shimadzu was not the original and first inventor or discoverer of the alleged inventions."

Respondents, in paragraphs 5, 7 and 15 of their bill of complaint (R. I, 8, 10, 14), alleged that the respective inventions were "not in *public* use or on sale in this country more than two years prior" to the dates of the applications for the respective patents. Petitioner, in paragraphs 5, 6 and 10 of its answer (R. I, 28, 29, 30), denied these allegations. Petitioner likewise alleged in its answer, paragraph 18 (R. I, 32) that:

" . . . it was successfully making, using and selling its product long before it ever heard of Shimadzu or of his alleged inventions and patents,"

(11) In addition to the express findings of both Courts below that petitioner's process and apparatus were experimental during the early part of the year 1921 and that in June 1921 petitioner began commercial production by its process and apparatus, adjudged to infringe respondents' patents—respondents themselves proved that petitioner's process and apparatus were not secret. This respondents did by calling as their voluntary witness to describe petitioner's process and apparatus, one Cooper, a former employee of petitioner and by proving that petitioner's process and apparatus had likewise been described to respondents by one Nagle, another former employee of petitioner (R. I, 401, 412, 423, 420).

(12) The inventions of petitioner's process and apparatus were made wholly independently of Shimadzu and his work (R. II, 1176-1177). The record contains no word of evidence that petitioner acquired any knowledge of the process or apparatus used by petitioner commercially since June 1921, from Shimadzu or his work, either directly or indirectly.

**SPECIFICATION OF ERRORS INTENDED TO BE
URGED.**

The Circuit Court of Appeals for the Third Circuit erred in the instant case:

(1) In holding that "plaintiff is undoubtedly entitled to rely for priority upon the date of invention and reduction to practice as found, regardless of the fact that the invention was made in a foreign country."

(2) In not holding that one who has made an invention in a foreign country and obtained a patent therefor in this country may not, for the purpose of overcoming the defenses of prior knowledge and use in this country and that the patentee is not the first inventor, carry back the date of the invention to the actual time of invention in the foreign country.

(3) In holding that the effective date of the invention of the claims, held valid and infringed, of the patents in suit was not later than August 1919.

(4) In not holding that the patent statutes of the United States proscribe all evidence of invention abroad other than that derived from patents, printed publications, or patent applications within the terms of RS4887.

(5) In not holding that testimony with respect to experiments and reduction of an invention to practice in foreign countries is incompetent and inadmissible under the statutes of the United States, to establish the date of invention of the thing patented or sought to be patented in this country.

(6) In not holding that under the patent statutes, the date of an invention made and first patented in a foreign

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country and thereafter in the United States upon a timely application, is the date of the application for the foreign patent.

(7) In not holding that the claims, adjudged valid and infringed, are invalid because the things patented were known and used by others in this country before the invention or discovery thereof by Shimadzu within the meaning of the patent statutes.

(8) In not holding that the claims, adjudged valid and infringed, are invalid because Shimadzu was not the first inventor.

(9) In not holding that the claims of patents Nos. 1,584,150 and 1,896,020, adjudged valid and infringed, are invalid because the process and apparatus of said claims were in public use in this country for more than two years prior to the actual filing of the applications for said patents in this country.

(10) In not holding that the claims of patents Nos. 1,584,149, 1,584,150 and 1,896,020, adjudged valid and infringed, are invalid because the inventions of said claims were suppressed and concealed by Shimadzu for more than two years after the subject-matter of said claims had been known and used commercially by others in this country.

(11) In holding any of the claims of any of the patents in suit valid and infringed and in granting respondents an injunction and an accounting.

SUMMARY OF ARGUMENT.

THE PATENTS IN SUIT ARE INVALID BECAUSE:

I. Save as provided in RS4887, an invention made abroad does not come within the contemplation or cognizance of the Patent Statutes of the United States unless and until it has been patented or described in a printed publication here or abroad, or the invention has been communicated and described to some person or persons in this country.

A. Under the patent statutes, the earliest dates to which Shimadzu is here entitled for his inventions are long subsequent to the commercial use by defendant of its Hardinge Mill, and process in June 1921.

(1) It follows,

(a) that the inventions were known and used by petitioner in this country before Shimadzu's invention or discovery thereof, within the meaning of the patent statutes, and

(b) that Shimadzu was, within the meaning of the patent statutes, not the first inventor of his alleged inventions:

II. If Shimadzu's acts in Japan are within the cognizance of the patent statutes of the United States, he suppressed, concealed and withheld his inventions until long after petitioner had brought into commercial use in this country inventions similar to or identical with his.

III. Petitioner's commercial use in June 1921 of its Harding Mill and process was, in law, a public use. Such use was more than two years prior to Shimadzu's applications for his patents 1,584,150 and 1,896,020.

ARGUMENT.**Point I.**

Save As Provided in RS4887, an Invention Made Abroad Does Not Come Within the Contemplation or Cognizance of the Patent Statutes of the United States Unless and Until It Has Been Patented or Described in a Printed Publication Here or Abroad, or the Invention Has Been Communicated and Described to Some Person or Persons in This Country.

Under this caption, the first eight and the eleventh Assignments of Error will be considered together.

The facts pertinent to this issue are believed to be those numbered (1) to (8) inclusive, pages 5 to 6, supra.

Under these facts, it would seem manifest that each of the three patents in suit is invalid unless Shimadzu can, by his acts in Japan, evinced by oral evidence, take the date of his inventions back of June 1921, the date when petitioner's commercial production in this country was begun by the processes and apparatus of the patents in suit.

Thus arises the naked question of law: whether the patent statutes of the United States permit or proscribe evidence of invention abroad, other than patents, printed publications, or patent applications within the terms of RS4887, to ascertain the date of an invention made abroad.

The answer to that question of law turns upon the construction, intent and meaning of the patent statutes of the United States, and particularly RS4886, 4887, 4904, 4920 and 4923⁸ being §§ 31, 32, 52, 69 and 72 respectively, of Title 35 U. S. C., as applied to the determination of the time when,

⁸ For convenient reference these sections are set out in an Appendix hereto.

and the acts by which, an inventor who made his invention in a foreign country brings his invention within the cognizance and operation of those statutes.

To the end that petitioner's position may not be misunderstood, petitioner concedes at the very outset that citizens of this country and aliens stand on the same footing under the patent statutes of the United States. One may obtain a patent under the same conditions as the other. Nor is petitioner here questioning the wisdom of Congress in so providing.

But though the patent statutes of the United States make no distinction between the rights thereunder of citizens and aliens, as persons, yet those statutes do place inventive acts performed abroad on an entirely different footing from inventive acts performed in this country.

The Congress itself has expressly recognized that the inventor of an invention made abroad is not entitled to the same rights of priority "*in interference and other proceedings arising in connection with such invention*", as the inventor of an invention made in this country.

In § 6 of the Nolan Act of March 3, 1921, 35 USC § 85, the Congress provided:

"Where an invention was made by a person while serving abroad, during the World War, with the forces of the United States, civil or military, the inventor thereof shall be entitled, in interference *and other proceedings* arising in connection with such invention, *to the same rights* of priority with respect of such invention *as if the same had been made in the United States*. (Mar. 3, 1921, c. 126, § 6, 41 Stat., 1314)."

In *Milburn Co. v. Davis etc. Co.*, 270 U. S. 390, 402, this Court likewise recognized a statutory difference in policy

between inventions made in this country and those made abroad. It there said:

“The policy of the statute as to foreign inventions obviously stands on its own footing.”

An examination of the statutes reveals that this difference in policy is found with respect to both novelty and priority of invention. Under § 6 of the Patent Act of 1836, 5 Stat. 117, novelty of an invention was defeated if the thing here invented had been known or used anywhere in the world by others prior to the date of such invention. Yet, by § 15 of the Patent Act of 1836, it was provided

“that whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication.”

Thus, §§ 6 and 15 of the Patent Act of 1836, construed together, provided that while prior use abroad would defeat a patent if such prior use were known,⁹ yet if a patent were granted without knowledge of such prior use, the patent could not thereafter be invalidated because of such prior foreign use if the thing here patented had not been previously patented or described in any printed publication.

By § 24 of the Consolidated Patent Act of 1870, 16 Stat. 198, the Congress removed this anomaly by adding the words “in this country” after the words “not known or

⁹ Sewell v. Jones, 91 U. S. 171, 179-180; Pennock v. Dialogue, 2 Pet. 20, 22; Dawson v. Follen, Fed. Cas. 3670.

used by others", and thus enacted that foreign knowledge or use by others "not patented, or described in any printed publication" should not deprive an invention here made, of novelty.

Notwithstanding the foregoing amendment to the provisions of § 6 of the Patent Act of 1836, denying to knowledge and use abroad of an invention, not patented or described in any printed publication, the status of a bar to a patent for an invention here made, yet the foregoing quoted provision of § 15 of the Patent Act of 1836 was retained in substance in § 25 of the Consolidated Patent Act of 1870. The result thereof is that since the enactment of the Consolidated Patent Act of 1870, the patent statutes of this country have expressly denied to knowledge and use abroad, even though the use be a public use,¹⁰ any effect, either to bar the granting of a patent or to invalidate a patent already granted.

The inevitable consequence of the inclusion in § 24 of the Consolidated Patent Act of 1870, 16 Stat. 198, after the words "not known or used by others" of the words "in this country", was that novelty and priority of an invention made in this country could not be negated by knowledge or use, even public use, abroad unless evidenced by patents or printed publications. This remained the law until the Amendment of 1903 to RS4887.

By that Amendment, *certain foreign applications for patents* filed in certain classified countries were added to this exception to the general rule that acts abroad are not within the contemplation of the patent statutes of this country unless such foreign acts are evidenced by patents or printed publications. The statutory denial of recognition

¹⁰ Gandy v. Main belting Co., 143 U. S. 587.

or effectiveness to any acts abroad other than as evidenced by patents, printed publications and patent applications within the purview of RS4887, is general. It is not a denial of recognition and effectiveness of such acts only as against one who seeks or obtains a patent for an invention made in this country. *It is a denial in favor of the general public* as well as in favor of him who seeks or obtains a patent monopoly. In fact, the patent statutes of this country were enacted primarily for the benefit of the general public and only incidentally in favor of an applicant for a patent, or a patentee.¹¹

That the patent statutes do not take cognizance of, or give any effect to acts abroad, other than those evinced by patents, printed publications and certain foreign applications for patents within the purview of RS4887, has been recognized not only by the Congress in its enactment of Sec. 6 of the Nolan Act, 35 U. S. C. § 85, but as well by the Patent Office tribunals and the courts.

For far more than half a century, the Patent Office and the Courts of the District of Columbia having appellate jurisdiction over the final decisions of the Patent Office have ruled in interference proceedings in an unbroken line of cases,¹² that unless and until inventions made abroad are

¹¹ Kendall v. Winsor, 21 How. 322, 328; U. S. Constitution, Article I, Sec. (8) Clause 8.

¹² Tucker v. Davis, 2 O. G. 224; Hovey v. Hufeland, 2 O. G. 493; Carr v. Davids, 3 O. G. 440, C. D. (1873) 79; Smith v. Barter, 7 O. G. 1, C. D. (1875) 5, 7, 8; Chambers v. Duncan, 9 O. G. 741, C. D. (1876) 82; 10 O. G. 787, C. D. (1876) 223; Lauder v. Crowell, 16 O. G. 405, C. D. (1879) 177; Thomas v. Reese, 17 O. G. 195, C. D. (1879) 335; Bell v. Brooks, 19 O. G. 290, C. D. (1881) 4; Roschack v. Walker, C. D. 1889, 157; 88 O. G. 1333; Rousseau v. Brown, 104 O. G. 1120, 21 App. D. C. 73; DeKando v. Armstrong, 37 App. D. C. 314, 321, 169 O. G. 1185, C. D. (1911) 413; Lorimer v.

made accessible to the American public in ways provided by the statutes, they are not within the cognizance of the patent statutes and that such foreign inventions can be made so accessible, in the absence of actual disclosure in this country, only through the disclosure thereof in a patent (RS4886), in a printed publication in this or any foreign country (RS4886), or, in a case falling within the purview of RS4887, in an application filed abroad.

Prior to the Amendment of 1903 to RS 4887, 32 Stat. 1225, one who made his invention abroad was not permitted, under the statutes, on an issue of priority, to establish the date of his foreign invention even by his foreign application for a patent,—far less by oral testimony.

Construing R. S. 4886, it was held in *Bell v. Brooks*, 19 O. G. 290, C. D. (1881) 4, as stated in the syllabus:

“Testimony in reference to experiments *and reduction to practice* in foreign countries, whether the invention be that of an American citizen or foreigner, is incompetent and inadmissible, the Revised Statutes of the United States proscribing all other evidence of invention abroad than that derived from patents or printed publications.”

As early as 1875 it was said by the Commissioner of Patents in *Smith v. Barter*, 7 O. G. 1, C. D. (1875) 5, 7, that to admit evidence of conception and actual reduction to practice in a foreign country would upset “the long established practice of the Office”.

The reason or policy lying behind the statute was stated in the case of *Tucker v. Davis*, 2 O. G. 224, thus:

Erickson, 227 O. G. 1445, 44 App. D. C. 503; *Rebuffat v. Crawford*, 68 Fed. (2d) 980, 982; *Wilson v. Sherts*, 81 Fed. (2d) 755, 760.

“A device existing in a foreign country, unless it has been patented or described in a printed publication, so that there is no reasonable probability that it may be known here, is of no benefit to the public of this country. The law proceeds altogether upon the ground that the inventor confers a benefit on the public here, and it specially encourages and protects him for that reason. A foreign inventor, whether a citizen of the United States or not is immaterial, can only benefit the public here by publishing his invention here. The original inventor first to produce his invention in this country, either by inventing it here or by bringing it with him from abroad, is the first to have done an act capable of working a benefit to the public here, and the one to be rewarded by a patent. It follows that evidence of any act not coming within the limitation would not be pertinent to an issue upon a question of priority of invention and should not be admitted.”

Since the Amendment of RS4887 in 1903, the tribunals of the Patent Office and the Court of Appeals of the District of Columbia have modified the pre-existing rule in accordance with the terms of that Amendment, but only to the extent of permitting a foreign inventor to establish the date of his foreign invention by his foreign application in cases falling strictly within the terms of the Amendment.

Thus, in *Wilson v. Sherts*, 81 Fed. (2d) 755, 761, 762, the Court of Customs and Patent Appeals said:

“The right of a party to have the benefit of the filing date of a foreign application for a patent as a constructive reduction to practice is purely statutory. Without the benefit of said section 4887, R. S., appellants would not be entitled to consideration of their British provisional application at all. It seems to us that *the right of the appellants to the benefit of their*

activities abroad must be found within the four corners of this statute, and the only right thus granted is the benefit of the filing date of the foreign application."

The Amendment of 1903 to RS4887 is a priority statute conferring rights with respect to inventions made abroad that did not theretofore exist. Manifestly, if prior to the enactment of that Amendment, one who made his invention abroad had been entitled to show by oral testimony or even by his foreign application, the date of his invention abroad, the Amendment of 1903 to RS4887 would have been a work of supererogation.

Moreover that Amendment is not restricted to Patent Office interferences. It applies in whatever proceeding the priority issue arises. It applies in infringement suits upon the issue of priority with the same force that it possesses in interference proceedings in the Patent Office.

In suits under RS4915, 35 USC § 63, the patent statutes have been interpreted in like manner by the inferior courts.¹³

In infringement suits the statutes have been given the same construction in the determination of priority between the foreign inventor plaintiff and a third person who made the same invention in this country which was subsequently patented.¹⁴

The same construction of the patent statutes has been applied generally by some of the Courts in patent infringement suits.

¹³ Westinghouse Mach. Company v. General Electric Company, 207 Fed. 75, 78.

¹⁴ Electrical Accumulator Co. v. Julien Electric Co., 38 Fed. 117, 128; Brush Electric Co. v. Julien Electric Co., 41 Fed. 679, 686; Electrical Accumulator Co. v. Brush Electric Co., 52 Fed. 130, 134 (C. C. A. 2); Vacuum Engineering Co. v. Dunn, 209 Fed. 219 (C. C. A. 2); Patents Selling & Exporting Co. v. Dunn, 213 Fed. 40 (C. C. A. 2).

Thus, in *Ireson v. Pierce*, 39 Fed. 795, 798, Circuit Judge Colt said:

“Under §§ 4886, 4920, 4923, Rev. St., the *only* evidence that can be used in proof of a foreign invention *for any purpose* is that coming through the channel of a patent or printed publication.”

In *Jay v. Weinberg*, 250 Fed. 469, 472, which involved the question of priority of invention coming within the terms of RS4887, as amended in 1903, the Court said:

“The foreign application date is therefore the effective date of this patent.”

The foregoing decisions are in harmony not only with the letter of the statutes and essential to avoid results glaringly absurd and prejudicial to the rights of the general American public and to the advantage of those having or seeking a patent monopoly, but they are, as well, in harmony with the broad purpose, object and spirit of the patent statutes as provided in Article I, Section 8, Clause 8 of the Federal Constitution¹⁵ and as declared from time to time in the decisions of this Court.

In *Gayler v. Wilder*, 10 How. 477, 497, Mr. Chief Justice Taney, speaking for the Court, said:

“If the foreign invention had been printed or patented, it was already given to the world and open to the people of this country, as well as of others, upon reasonable inquiry. They would therefore derive no advantage

¹⁵ Art. 1, Sec. 8, Cl. 8: “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;”

The constitutional provision “means progress in this country.”

Ex Parte Grosselin, 97 O G 2977, C D (1901) 248.

from the invention here. It would confer no benefit upon the community, and the inventor therefore is not considered to be entitled to the reward. *But if the foreign discovery is not patented, nor described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach; and, as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them, and places it in their possession. And as he does this by the effort of his own genius, the law regards him as the first and original inventor, and protects his patent, although the improvement had in fact been invented before, and used by others.*"

In *Brown v. Duchesne*, 19 How. 183, 195, this Court, speaking of the Constitutional grant and the patent statutes, said:

"The power thus granted is domestic in its character and necessarily confined within the limits of the United States."

"But these acts of Congress do not, and were not intended to, operate beyond the limits of the United States;"

In *Gardiner v. Howell*, 2 Cliff. 462, Fed. Cas. No. 5219, Clifford J. said:

"The patent laws of the United States afford no protection to inventions beyond or outside of the jurisdiction of the United States."

Robinson on Patents, Vol. I, page 538, § 382 says:¹⁶

¹⁶ This statement by Robinson was made prior to the Amendment of 1903 to RS4887.

"Under our law no notice is or can be taken of any inventive act performed abroad until its result is published either in a patent or a printed book. At whatever date, therefore, an unpatented or unpublished foreign invention may have been in fact conceived by its inventor, its conception in the United States takes place only when it becomes an object of intellectual apprehension within the limits of this country. Thus if the inventor, having completed the mental part of his inventive act abroad, comes into the United States, not having already given his invention to the world, the date of his arrival on our shores is the date recognized by our law as the date of his conception; or if he entrusts his secret to an agent, whom he sends into this country upon business connected with the invention, the conception dates from the moment when the agent comes within our boundaries. Hence when a question of priority arises between inventions, one of which was conceived in the United States, while the other had its origin in a foreign country, the rules by which the date of each is ascertained are very different. In the American invention the date of the conception is carried back to the instant when the inventor can be shown to have first clearly apprehended his idea of means; in the foreign invention only to the moment when some person to whom the conception was familiar came within the area of the United States. Where both inventive acts have been performed abroad and neither has been patented, the date of the first application in the United States is held to fix the date of first conception; while if one has been patented, the other not, the former has priority; and if both have been patented the date of the first patent is the date of first conception."

Walker on Patents, Deller's Edition, Vol. II, page 918, § 200, says:

"Where the conception occurred in a foreign country, it receives a conception date contemporaneous with its communication to someone in the United States."

Notwithstanding the provisions of RS4886, 4887, 4904, 4920, 4923, § 6 of the Nolan Act, 35 USC § 85, and the foregoing decisions, some of the inferior courts including the Courts below have held, in patent infringement suits, based on patents for inventions made in a foreign country, that the patentee may carry back the date of the invention of the patent in suit, as against knowledge and use in this country by a non-patentee defendant, to the actual date thereof in the foreign country.¹⁷ In so holding, the inferior courts have failed, it is believed, to construe the several sections of the patent acts in their entirety and as a whole (*Gayler v. Wilder*, 10 How. 477, 496), and to appreciate not only the broad purpose, object and spirit of the patent statutes, but as well the true intent and meaning thereof as expressed in those statutes themselves and in the decisions of the Courts.¹⁸

It seems likewise clear that such courts have also overlooked that a patent infringement suit, in which the defendant pleads, inter alia, as here, that the patentee of the patent in suit is not the first inventor, raises the same issue of priority of invention as does an interference proceeding in the Patent Office under RS4904; and that one may be an inventor though not a patentee or an applicant for a patent.

¹⁷ *Hanifen v. E. H. Godshalk*, 78 Fed. 811; *Hanifen v. Price*, 96 Fed. 435; *Welsbach Light Co. v. American Incandescent Lamp Co.*, 98 Fed. 613; *Badische Anilin & Soda Fabrik v. A. Klipstein & Co.*, 125 Fed. 543; *Claude Neon Lights Co. v. Rainbow Light*, 47 Fed. (2d) 345.

¹⁸ Indeed, the express recognition in RS4886 and RS4923 of patents and printed publications and, in RS4887, of foreign applications for patents coming within the purview of that statute, as evidence of inventions made abroad, constitutes, under settled principles of law, a statutory denial of the right to establish such foreign inventions by any other evidence.

Again under RS4886, an inventor is one who "may", by reason of his compliance with the conditions prescribed by that statute, obtain a patent for his invention. To obtain a patent, the applicant must be an inventor. Neither his application for a patent nor the grant of a patent to him, makes him an inventor.

The proceeding in the patent office in an interference is, in the terms of the statute, RS4904, one "to determine the question of priority of invention".

RS4920 provides, *inter alia*,

"In any action for infringement, the defendant . . . may prove on trial . . .

"Fourth. That he (the patentee) was not the original and first inventor or discoverer of any material and substantial part of the thing patented;"

In the case at bar, petitioner pleaded (R. I, 34, at top)

" . . . Shimadzu was not the original and first inventor or discoverer of the alleged inventions."

Under such an issue, defendant may show that the patentee was not the first inventor, even though it is not made to appear who did invent the thing patented.

In *Milburn Co. v. Davis etc. Co.*, 270 U. S. 390, 401, this Court said:

"It is not necessary to show who did invent the thing in order to show that Whitford (the patentee) did not."

Manifestly, if the patentee of the subject matter of the claims of the patent sued upon in an infringement suit is an inventor, anyone else who independently conceives the same thing and reduces it to practice is likewise an inventor,

regardless of whether the latter does or does not obtain, or even apply for, a patent therefor.¹⁹

This principle was stated in *Boyce v. Stewart-Warner Speedometer Corp.*, 220 Fed. 118, 124 (CCA2) thus:

“And if prior invention is shown to have existed and been in use, it is clearly of no consequence whether it was patented or not.”

The decisions of the Courts below make the right of a foreign inventor to carry back the date of his invention to the actual date thereof in a foreign country, turn upon whether his adversary has, or is seeking, a patent monopoly. If his adversary has a patent for an invention made in this country or has applied for a patent for an invention made in this country, the date of the invention abroad may *not* be carried back of the date of its disclosure in this country, otherwise than by prior patent therefor, by description of the invention in a printed publication, or by the filing of an application for a foreign patent meeting the requirements of RS4887. If, however, his adversary is not seeking, or *has not obtained a patent monopoly* for himself but is a member of the general public engaged in commercial production, the foreign inventor may, *under such decisions*, carry back, by oral testimony, the date of his invention to the actual date of invention in a foreign country.

The evil consequences of such a result are both obvious and serious. Under such construction domestic inventors, especially those engaged in commercial enterprises *must* apply for and obtain patents for their every invention in order that their factories and plants, in the operation of which the use of such invention is essential, be not closed

¹⁹ *Kendall v. Winsor*, 21 How. 322, 328; *Corona Co. v. Doan Corp.*, 276 U. S. 358, 382.

by an injunction issuing in an infringement suit based upon a patent for the same invention made abroad, which patent could not have been obtained had the domestic inventor applied for a patent for his invention.

Indeed, under these decisions, a domestic inventor could not donate or abandon his invention to the public with any assurance that the public might not be enjoined from using it because of a later patent for an invention made abroad, which patent could not have been obtained, had the American inventor sought and obtained a patent monopoly for his invention.²⁰

This Court has long recognized that the construction of statutes, to avoid results glaringly absurd, is one of its judicial functions.²¹

As is well said in Stringham's *Outline of Patent Law*, 1937, page 193,

"Under any statute, the law ought not to be more favorable to one asserting right to monopoly against the public, than it is to one asserting right to a monopoly as against a rival claimant to the monopoly. The notion of two kinds of patentable 'new' seems utterly unwarranted."

Because the patent statutes recognize inventive acts, knowledge or use abroad, *only* when evinced by patents, printed publications or applications for patents within the purview of RS4887, the earliest date to which Shimadzu is here entitled for his alleged inventions is long subsequent to the commercial use by petitioner of its Hardinge Mill and process at Philadelphia in June, 1921.

²⁰ Ex Parte Grosselein, 97 O. G. 2977, C. D. (1901) 248.

²¹ Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 51 October Term, 1938. Opinion filed December 5, 1938, and cases there cited.

It follows:

- (a) That the alleged inventions of the patents in suit are wanting in novelty because of knowledge and use thereof by the petitioner in this country before Shimadzu's invention or discovery thereof within the meaning of the patent statutes, and
- (b) that Shimadzu was not, within the meaning of those statutes, the first inventor of his alleged inventions.

The patents in suit are hence invalid.

Point II.

If Shimadzu's Acts in Japan Are Within the Cognizance of the Patent Statutes of the United States, He Suppressed, Concealed and Withheld His Inventions Until Long After Petitioner Had Brought Into Commercial Use in This Country Inventions Similar to or Identical With His.

Under this caption, Assignments of Error Nos. 10 and 11 are considered.

The Courts below found that the invention of patent 1,584,150 was made in Japan in August, 1919 (R. II, 1166). It is clear that the Courts below intended this date to apply to the inventions of patents 1,584,149 and 1,896,020, as well (R. II, 1188).

The Courts below likewise found that Shimadzu, in and prior to November, 1920, filed applications for Japanese patents (R. II, 1168), and held (R. II, 1172),

"We are not concerned with the motives which prompted him in taking out the '563 patent (applied for in Japan November 27, 1920) to confine it to the single step of mechanical removal of dust from the

drum and to *withhold the really essential steps of the invention for later patenting*. It is sufficient to say that he had a right to do this if he chose."

Shimadzu did not file his applications for United States patents 1,584,150 and 1,896,020 until July 14, 1923, and April 27, 1926, respectively. The date on which each of these applications was filed was more than two years after June, 1921, the date upon which the Courts below found that petitioner began its commercial use in Philadelphia, by the Hardinge Mill, of the inventions of those patents (R. II, 1192). Indeed, Shimadzu's application for his patent 1,584,149 was not filed until January 30, 1922, many months after petitioner's process which was held by the Courts below to infringe that patent, was in commercial use.

Should the acts of Shimadzu in Japan be found of any avail to respondents in fixing the date of his inventions, it becomes manifest that after his inventions were complete in August, 1919, he deliberately suppressed and withheld his inventions from the people of this country until long after inventions similar to or identical with his own, had been brought into commercial use in this country by petitioner.

Under such circumstances, it is believed that his invention must be deemed to have been abandoned and that this view is supported by decisions of this Court.

In *Kendall v. Winsor*, 21 How. 322, 328, this Court said:

"By correct induction from these truths, it follows, that the inventor who designedly, and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote, and, if aided in his design, would impede, the progress of science and

the useful arts. And with a very bad grace could he appeal for favor or protection to that society which, if he had not injured, he certainly had neither benefited nor intended to benefit. Hence, if, during such a concealment, an invention similar to or identical with his own should be made and patented, *or brought into use without a patent*, the latter could not be inhibited nor restricted, upon proof of its identity with a machine previously invented and withheld and concealed by the inventor from the public. The rights and interest, whether of the public or of individuals, can never be made to yield to schemes of selfishness or cupidity; moreover, that which is once given to or is invested in the public, cannot be recalled nor taken from them."

In *Wirebounds Patents Co. v. Saranac Automatic Mach. Corp.*, 65 Fed. (2d) 904, 906, the CCA6, after discussing the cases of *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U. S. 463, *Chapman v. Wintroath*, 252 U. S. 126, and *Woodbridge v. United States*, 263 U. S. 50, held:

"The rationale of these three cases is that if the inventor, intentionally or by reason of culpable neglect, be guilty of action which unduly postpones the time when the public would be entitled to the free use of the invention, and thus defeats the policy of the patent law, the right to a patent will be lost."

In *Victor Talking Mach. Co. v. Starr Piano Company*, 281 Fed. 60, 66, the CCA2 said:

"... Johnson for years relied upon keeping his process secret. Such construction was a clear abandonment under the decisions."

In *Rifle and Cartridge Co. v. Whitney Arms Co.*, 118 U. S. 22, 24-25, this Court said:

"Such abandonment may be proved either by express declarations of an intention to abandon or by conduct inconsistent with any other conclusion."

As Shimadzu was filing applications for patents in Japan and elsewhere after August, 1919, but delayed filing any application anywhere for the inventions of the patents here in suit until long after the same or like inventions had gone into commercial use in this country, it would seem manifest under the foregoing authorities that the inventions of the patents in suit and each of them must be deemed to have been concealed, suppressed or abandoned and that those patents must therefore be adjudged invalid.

● Point III.

Petitioner's Commercial Use in June, 1921, of Its Hardinge Mill and Process Was, in Law, a Public Use. Such Use Was More Than Two Years Prior to Shimadzu's Applications for His Patents 1,584,150 and 1,896,020.

Under this caption, Assignments of Error Nos. 9 and 11 are considered.

Under Point I, we believe that we have shown that the patents in suit are wanting in novelty. *Walker on Patents*, Deller's Edition, pages 261-2, says:

"Novelty is negatived by prior knowledge and use in this country, by even a single person, of the thing patented. . . . This rule applies even to cases where that knowledge and use were purposely kept secret. . . . And it applies no matter whether or not the prior structure was used."

Under this Point, it is our purpose to establish that the patents in suit, 1,584,150 and 1,896,020, are likewise invalid because of the statutory bar of both RS4886 and RS4887, of public use in this country for more than two years prior to the *filing of the applications* in this country for those patents. The Courts below found (R. II, 1192):

"It is therefore plain that there is no evidence of anything beyond an experimental use by the defendant earlier than about the middle of the year 1921 . . . Commercial production (by petitioner) by the Hardinge Mill with its forced air draft undoubtedly involved the use of the plaintiff's patent, and June 1921 may be fixed as the date when that began."²²

It is manifest from the foregoing finding of the Courts below that petitioner's production in June, 1921, was commercial and in contrast with the experimental use of the inventions earlier in the year 1921.

²² The Hardinge Mill was installed and operated by petitioner under the direction of Mr. C. A. Hall. Later Mr. Hall applied for a patent for the apparatus described and claimed in patent to him No. 1,675,345. (R. III, 37.) Hall likewise applied for and obtained a patent No. 1,888,823 for a process and a product. (R. III, 44.) While the last mentioned application was pending, Shimadzu's patent 1,584,150 issued. Hall then added certain claims thereof to his application. An interference, No. 54,798, was declared. The counts not involving lead suboxide were held unpatentable by the Examiner of Interferences and were dropped from the interference.

The Court of Customs and Patent Appeals held (*Hall v. Shimadzu*, 59 Fed. (2d) 225) that "the production of suboxide of lead is the very heart of each of the counts where the phrase under consideration occurs and this phrase is necessary 'to give life and meaning and vitality' to the counts, . . ."; that in Hall's specification, as originally filed, "the words 'suboxide of lead' are nowhere found"; and that Hall's specification, as originally filed "does not warrant claims corresponding to the (lead suboxide) counts here in issue; . . ."

Consequently, Shimadzu was awarded priority on the counts in issue and Hall's patents issued without claims in the language of the counts.

The Courts below found (R. II, 1185) that

"He (Shimadzu) has not established the fact that suboxide is to be found in the defendant's (petitioner's) product . . ."

Shimadzu's application for patent 1,584,150 was filed July 14, 1923. His application for patent 1,896,020 was filed April 27, 1926.

The filing date of each application was therefore more than two years after June, 1921.

Under the foregoing finding of the Courts below, petitioner's use from June, 1921, was a commercial use. It was not experimental (R. II, 1192).

There is no evidence, moreover, that such use was secret. On the contrary, respondents themselves showed that it was available to the public in the minutest detail. For respondents without objection by petitioner, adduced, by the testimony of one of petitioner's former employees (Cooper) evidence to prove the precise process and apparatus that had been used by petitioner (R. I, 401, 412). Respondents likewise proved that petitioner's process and apparatus had been described and explained to them by another former employee (Nagle) of petitioner (R. I, 420, 423).

Under such facts established by the respondents themselves, respondents are precluded and barred from now asserting that petitioner's use of its process and apparatus was secret and not available to the public.

In fact, the Circuit Court of Appeals for the Eighth Circuit in *Twyman v. Radiant Glass Co.*, 56 Fed. (2d) 119, 121, held, as we understand that decision, that commercial use in the absence of countervailing evidence, is a public use. In that case, the patent was for a mold for glass cylinders. In holding the patent for the mold invalid because of defendant's use of the mold in the manufacture of its product for purposes of trade for more than two years prior to the date of the plaintiff's application, the Court said:

“There is nothing in the record to sustain plaintiff’s contention that the art of making glass molds was in the experimental stage at the time he entered the field. *For more than two years prior to that time, defendant had been using the accused device in the manufacture of these molds commercially* and in substantial numbers for sale to the public. They were being so manufactured *for the purposes of the trade and for profit*. There is nothing to indicate that they were being manufactured for experimental purposes, but, if used mainly for purposes of trade, and incidentally as an experiment, *the use would still be a public one.*”

This conclusion of the court in the *Twyman* case finds support, it is believed, in the decisions of this Court in *Egbert v. Lippman*, 104 U. S. 333, *Brush v. Condit*, 132 U. S. 39, 40, and *Manning v. Cape Ann Isinglass & Glue Co.*, 108 U. S. 462.

In their brief in opposition to the petition for a writ of certiorari in this case, respondents took the position that petitioner had not set up in its pleading the defense of two years’ public use. Respondents are mistaken.

Among the defenses set up in petitioner’s answer were these (R. I, 35):

“Defendant avers that the claims of said letters patent are invalid and void because the subject matter thereof was, prior to the alleged invention thereof by Shimadzu, and for more than two years prior to his application dates, known to and used by the defendant at Philadelphia, Pennsylvania, and by the Willard Storage Battery Co. at Cleveland, Ohio.”

Respondent’s, in paragraphs 5, 7 and 15 of their bill of complaint, alleged that the respective inventions of patents 1,584,150, 1,584,149 and 1,896,020 were “not in public use or on sale in this country more than two years prior” to

the dates of the applications for these respective patents. (R. I, 810, 14). Petitioner, in paragraphs 5, 6 and 10 of its answer, denied those allegations. (R. I, 28, 29, 30.) Petitioner likewise alleged in its answer, paragraph 18 (R. I, 32) that:

" . . . it was successfully making, using and selling its product long before it ever heard of Shimadzu or of his alleged inventions and patents."

Moreover, respondents did not object to petitioner's answer on the ground of inadequacy or object to any testimony offered by petitioner that its two years' use of its process and apparatus prior to the filing date of Shimadzu's applications for patents 1,584,150 and 1,896,020, was a public use. Under the decisions of this and other Courts, respondents' failure so to do must be deemed a waiver of their right now to object upon that ground.

Roemer v. Simon, 95 U. S. 214, 220.

Loom Co. v. Higgins, 105 U. S. 580, 596.

Planing Machine Co. v. Keith, 101 U. S. 479, 492, 493.

Roberts v Graham, 6 Wall. 578, 581.

Chickasha Cotton Oil Co. v. Roden, 66 F. (2d) 127 (C. C. A. 10).

In *Roberts v. Graham*, 6 Wall. 578, 581, this Court expressed the general rule applicable in such cases thus:

"The objection of variance not taken at the trial, cannot avail the defendant as an error in the higher court, if it could have been obviated in the court below; . . ."

In *Roemer v. Simon*, 95 U. S. 214, 220, respondents pleaded prior knowledge and use by certain persons desig-

nated in the answer. Two witnesses not so named were examined upon that subject by respondents without objection. Upon these facts, the Court said:

"Previous notice of the examination of those two witnesses, it seems, was not given; but the presiding justice states that, if seasonable objection had been made, the evidence would have been excluded. None such was made; and it is well-settled law that the failure to interpose any such objection before the final hearing is a waiver of the required notice in an equity suit. *Brown v. Hall*, 6 Blatch. 405."

The conclusion, with or without respondents' own acts in establishing that petitioner's process has at all times been available to the public, is, it is believed, inevitable that petitioner's use in June 1921 was a public use and a statutory bar to patents 1,584,150 and 1,896,020.

CONCLUSION.

For the foregoing reasons, it is believed that each and all of the patents, 1,584,149, 1,584,150 and 1,896,020, here in suit, are invalid and should be so adjudged and that the decree of the Court below should be reversed with directions to dismiss the bill of complaint.

January 2, 1939.

Respectfully submitted,

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Attorney for Petitioner.

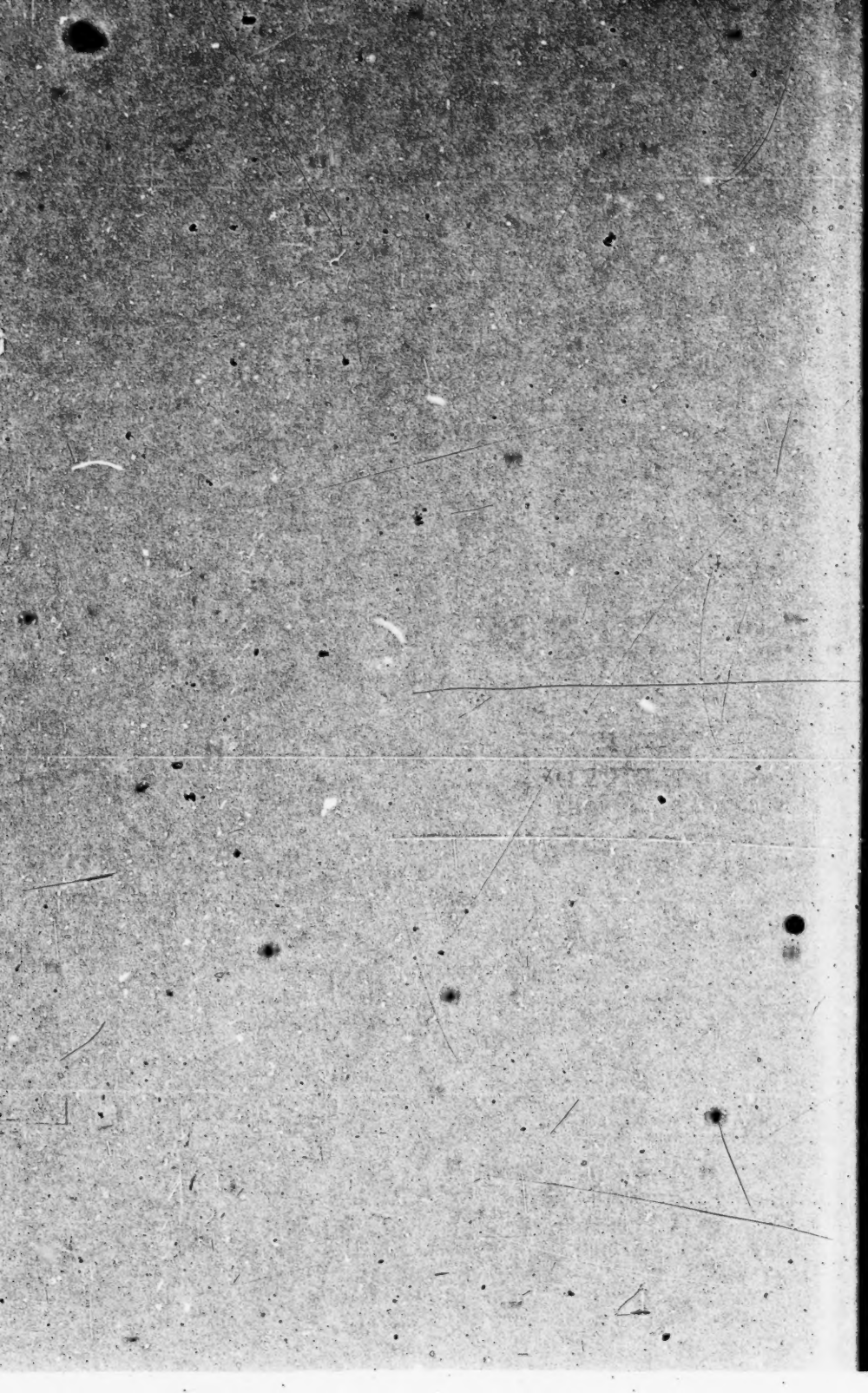
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APPENDIX.

**CONTAINING REVISED STATUTES 4886, 4887, 4904,
4920, 4923 AND § 6 OF THE NOLAN ACT,
BEING RESPECTIVELY**

§§ 31, 32, 52, 69, 72 and 85 of Title 35 U. S. C.

**TOGETHER WITH THE STATUTORY
HISTORY OF R. S. 4886, 4887 and 4923:**



RS4886.

"*Section 31. Inventions patentable.* Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others *in this country*,¹ before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application; and not in public use or on sale *in this country*² for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. § 4886; Mar. 3, 1897, c. 391, § 1, 29 Stat. 692.)"

RS4887.

"§ 32. *Inventions previously patented abroad.* No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

¹ Inserted by amendment of 1870 (16 Stat. 198).

² Inserted by amendment of 1897 (29 Stat. 692); but prior thereto in *Gandy v. Main Belting Company*, 143 U. S. 587, decided in 1892, this Court construed the statute as if those words had then been included therein.

³ "An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section 31 of this title, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. (R. S. § 4887; Mar. 3, 1897, c. 391, § 3, 29 Stat. 693; Mar. 3, 1903, c. 1019, § 1, 32 Stat. 1225.)"

RS4904.

"§ 52. *Interferences; determination of priority; issue of patent.* Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine *the question of priority of invention.* And

³ The whole of this paragraph had its origin in the amendment of 1903 (32 Stat. 1225).

the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe. (R. S. § 4904.)”

RS4920.

“§ 69. *Pleading and proof in actions for infringement.*

In any action for infringement the defendant may plead the general issue; and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

“First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

“Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

“Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

“Fourth. That he was not the original and first inventor or discoverer or * any material and substantial part of the thing patented; or,

“Fifth. That it had been in public use or on sale in this country for more than two years before his ap-

* “or” should be “of”.

plication for a patent, or had been abandoned to the public.

“And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents; and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. (R. S. § 4920; Mar. 3, 1897, c. 391, § 2, 29 Stat. 692).”

RS4923.

“§ 72. *Patent not void for previous use of thing in foreign country.* Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. (R. S. § 4923).”

§ 6 OF THE NOLAN ACT.

“§ 85. *Rights as to inventions made while serving abroad with United States forces during World War.* Where an invention was made by a person while serving abroad, during the World War, with the forces of the United States, civil or military, the inventor

thereof shall be entitled, in interference and other proceedings arising in connection with such invention, to the same rights of priority with respect of such invention as if the same had been made in the United States. (Mar. 3, 1921, c. 126, § 6, 41 Stat. 1314.)”

STATUTORY HISTORY OF R. S. 4886.

The Patent Act of 1790 (1 Stat. 109), provided in § 1 thereof for the grant of Letters Patent,

“ . . . upon the petition of any person or persons . . . setting forth that he, she, or they hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, . . . ”

The Patent Act of 1790 was repealed by the Patent Act of 1793 (1 Stat. 318), which in § 1 provided:

“That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause Letters Patent to be made out in the name of the United States, . . . ”

In 1836 this act was replaced by the Patent Act of that year (5 Stat. 117), § 6 of which provided:

“That any person or persons, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use, or on sale, with his consent or allowance, as

the inventor or discoverer; and shall desire to obtain an exclusive property therein; may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor."

The Patent Act of 1836 in turn was repealed by the Consolidated Patent Act of 1870 (16 Stat. 198). § 24 of the latter Act provided:

"That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor."

Upon the enactment of the Revised Statutes in 1874, § 24 of the Consolidated Patent Act of 1870 became, without change, R. S. 4886.

In 1897 R. S. 4886 was amended (29 Stat. 692) to read thus:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, un-

less the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

The amendment of R. S. 4886 by the Act of May 23, 1930 (46 Stat. 376) is not here pertinent.

STATUTORY HISTORY OF R. S. 4887.

R. S. 4887 had its origin in § 8 of the Patent Act of 1836, which provided in part as follows:

"But nothing in this act contained shall be construed to deprive an original and true inventor of a right to a patent for his invention, by reason of his having previously taken out Letters Patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings."

By an amendment contained in § 6 of the Patent Act of 1839 (5 Stat. 353), the foregoing provision of the Patent Act of 1836 was changed to read:

"That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided*, That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided also*, That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign Letters Patent."

By § 25 of the Consolidated Patent Act of 1870 the provision was again changed to read:

“That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country: *Provided*, The same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years.”

In 1874 this Section became, with certain modifications, § RS4887 of the Revised Statutes enacted in that year, as follows:

“No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.”

Again, in the Patent Act of 1897, the statute was amended to read thus:

“No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application

for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country."

Finally, by the amendment of 1903, (32 Stat. 1225) R. S. 4887 was given its present form, which it has since retained, save for the extension, by the amendment of June 19, 1936 (49 Stat. 1529), of the convention period in cases of designs from four to six months.

STATUTORY HISTORY OF R. S. 4923.

R. S. 4923 first appears as § 16 of the Patent Act of 1836, which provided:

"That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication."

With slight modifications in terminology, not affecting the substance, § 15 of the Patent Act of 1836 was re-enacted as § 62 of the Consolidated Patent Act of 1870, which read thus:

"That whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication."

In 1874 §62 of the Consolidated Patent Act of 1870, beginning with the words "Whenever it appears that a patentee", instead of "That whenever it shall appear that the patentee", became § 4923 of the Revised Statutes. The statute has not since been changed.¹

¹ At the time when this statute was first enacted as § 15 of the Patent Act of 1836, it served as an express limitation, in favor of certain patentees, upon the right of an adversary to defeat a patent by proof of prior unpatented and unpublished knowledge and use abroad which, by § 6 of that Act were made available to defeat the grant of a patent. In 1870; however, the words "in this country" were inserted in § 24 of the Patent Act of 1870 after the words "not known or used by others". Thus, it would seem that the words "in this country" in § 24 of the Patent Act of 1870, and in R. S. 4886 and all subsequent revisions thereof, extended the policy and effect of R. S. 4923, which applies to patentees only, to everyone without distinction, and that R. S. 4923 is, therefore, *functus officio*.